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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/522,958	01/31/2005	Clarence W Andrews III	PU4870USW	6658

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GLAXOSMITHKLINE
CORPORATE INTELLECTUAL PROPERTY, MAI B482
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RESEARCH TRIANGLE PARK, NC 27709-3398

EXAMINER

LOEWE, SUN JAE Y

ART UNIT	PAPER NUMBER
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1626

NOTIFICATION DATE	DELIVERY MODE
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07/30/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/522,958	Applicant(s) ANDREWS ET AL.	
	Examiner SUN JAE Y. LOEWE	Art Unit 1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 May 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,7,14,17-21,23,25-30,43 and 44 is/are pending in the application.
- 4a) Of the above claim(s) 25-30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,7,14,18-21,23,43 and 44 is/are rejected.
- 7) ☒ Claim(s) 17 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>5-1-2008</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

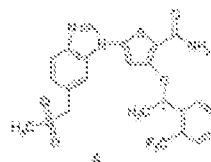
1. Claims 1-3, 7, 14, 17-21, 23, 25-30, 43 and 44 are pending in the instant application. Claims 25-30 remain withdrawn. Claims 1-3, 7, 14, 18-21, 23, 43 and 44 remain rejected. Claims 1-3, 7, 14, 17-21, 23, 43 and 44 remain objected to.

Response to Amendment/Arguments

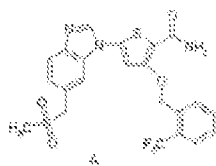
2. The claim amendments and arguments filed on May 1, 2008 have been fully considered. The claim amendments, in view of the arguments, are successful in overcoming the 35 USC 112 1st paragraph rejection which is hereby withdrawn. Applicant has not overcome the objection to claim 20 (Section 10, office action dated February 1, 2008); this ground of objection is maintained and hereby made FINAL.

3. Notwithstanding the non-allowability of the generic claims, to expedite prosecution, the

search and examination was extended to the non-elected species of



and



. The compounds were not allowable. Therefore, the generic claims were rejected. Non-elected species remain withdrawn from further consideration. Currently, the prosecution is still limited to the elected species.

Information Disclosure Statement

4. The information disclosure statement (IDS) submitted on May 1, 2008 was in compliance with the provisions of 37 CFR 1.97 and 37 CFR 1.98. The IDS was considered. A signed copy of form 1449 is enclosed herewith.

Claim Objections

5. Claims 1-3, 7, 14, 17-21, 23, 43 and 44 objected to for containing non-elected subject matter (ie. compounds of Formula I that are not the elected species).

6. Claim 20 objected to for not being written in proper Markush form. This ground of objection was set forth in the previous office action dated February 1, 2008.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

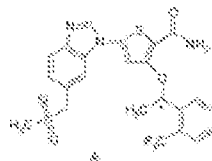
A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

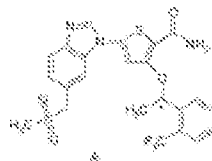
Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 1-3, 7, 14, 18-21, 23, 43 and 44 provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-3, 11, 13, 14 and 40 of copending Application No. 11/467,577. Although the conflicting claims are not identical, they are not patentably distinct from each other for the reasons provided below.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

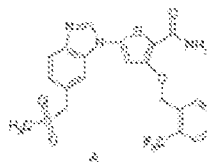
Determination of the scope and contents of claims 1-3, 11, 13, 14 and 40 of US Appl. 11/467,577
The claims are drawn to a Markush group of compounds with the same utility as that instantly claimed.



One preferred embodiment is the species of , which is also specifically claimed.

Ascertaining the differences between claims 1-3, 11, 13, 14 and 40 of US Appl. 11/467,577 and the claims at issue.

The preferred embodiment anticipates claims 43 and 44. The preferred embodiment is



the next higher homolog of the non-elected species of claims 1-3, 7, 14, 18-21 and 23. encompassed by

Resolving the level of ordinary skill in the pertinent art – Prima Facie Case of Obviousness.
MPEP § 2144.08.II.A.4(c) states “...consider teachings of a preferred species within the genus. If such a species is structurally similar to that claimed, its disclosure may motivate one of ordinary skill in the art to choose the claimed species or subgenus from the genus, based on the reasonable expectation that structurally similar species usually have similar properties”. This is a “Genus-Species Guidelines” for the examination based on 35 U.S.C. 103. An analogous guideline was followed here for the analysis of obviousness-type double patenting.

The preferred embodiment suggests to one of ordinary skill to make species which fall within the scope of the instant claims. Thus, the instant claims are *prima facie* obvious over claims 1-3, 11, 13, 14 and 40 of copending US Appl. 11/467,577.

Note: The following copending applications appear to have overlapping subject matter (including specific compounds) with the instant claims – 11/754,653; 10/597,828; 10/575,210; 12/113,324; 12/065,668; 12/065,684.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SUN JAE Y. LOEWE whose telephone number is (571)272-9074. The examiner can normally be reached on M-F 7:30-5:00 Est.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph McKane can be reached on (571)272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Sun Jae Y. Loewe, Ph.D./
7-18-2008

/Kamal A Saeed, Ph.D./
Primary Examiner, Art Unit 1626